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CARR & FERRELL LLP
2225 EAST BAYSHORE ROAD
SUITE 200
PALO ALTO, CA 94303

[REDACTED] EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No.	Applicant(s)
	09/553,877	PETERS ET AL.
	Examiner	Art Unit
	Carolyn M Bleck	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 April 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 and 15-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 24 April 2003. Claims 1-11 and 15-29 are pending. Claims 10, 11, and 16-20 have been amended. Claims 21-29 are newly added. Claims 12-14 have been cancelled.

Drawings

2. The corrected or substitute drawings were received on 24 April 2003. The objections to the drawings are hereby withdrawn due to the drawings filed on 24 April 2003.

Specification

3. The objections to the specification are hereby withdrawn due to the amendment filed on 24 April 2003.

4. The amendment filed 24 April 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The newly added recitations of "at least a first of said networked computers comprising an activity processor, said activity processor configured to execute one or more of a plurality of functions using said data, said functions relevant to administration

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of said organization, and at least a second of said networked computers comprising an activity scheduler, said activity scheduler configured to schedule execution of the one or more of a plurality of functions using the first of said networked computers, a first member of the plurality of functions being scheduled for immediate execution and a second member of the plurality of functions being scheduled for execution responsive to a queue,” within claim 21 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find any support for the interaction of the claimed first and second networked computers as claimed in 21 within the specification as originally filed.

The newly added recitations of “the first member of the plurality of functions is a critical insurance function and the second member of the plurality of functions is a non-critical insurance function” within claim 22 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find any support for the first and second members within the specification as originally filed.

The newly added recitations of “means for real time performance of a plurality of functions relevant to said administrative functions of said organization” and “means for predefining via said activity scheduler relative to said entered data that selected first types of entered data are to be processed by said activity processor in real time and that selected second types of said entered data are to be queued for processing at another time” within claim 29 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find any support for the means for real

time performance and a means for predefining via the activity scheduler performing the functions as claimed within the specification as originally filed.

As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

5. Claim 24 is objected to because of the following informalities: claim 24, lines 2-3, "a series of questions to a user and to receive answers in response, global data being responsive to the answers" appears to be grammatically incorrect. Appropriate correction is requested.
6. Claim 25 is objected to because of the following informalities: claim 25, line 4, "data storage configure for..." appears to be grammatically incorrect. Appropriate correction is requested.
7. Claim 29 is objected to because of the following informalities: claim 29, line 4, "networked said computers..." appears to be grammatically incorrect. Appropriate correction is requested.

Claim Rejections - 35 USC § 112

8. The rejections under 35 USC 112, second paragraph, are hereby withdrawn due to the amendment filed on 24 April 2003.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) As per claim 24, lines 2-3, "global data" lacks proper antecedent basis. For purposes of applying prior art, "global data" of claim 24 is being interpreted as data responsive to answers.

Claim Rejections - 35 USC § 101

11. The rejections under 35 USC 101 are hereby withdrawn due to the amendment filed on 24 April 2003.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in 24 April 2003 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in preceding sections above in the next communication sent in response to the present Office Action.

13. Claims 1-11 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (4,992,940) in view of Bosco et al. (5,191,522) for substantially the same reasons given in the previous Office Action (paper number 11). Further reasons appear hereinbelow.

(A) Claims 1-9 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 11; sections 11A-11E; pages 6-11).

(B) Claim 10 has been amended to include the recitations of "data input", "a plurality of networked computers", and "preexisting data". As per the limitation of "data input", Dworkin teaches a terminal for manually entering in data (col. 4 lines 3-12, col. 2 lines 6-18, and Figure 1), a means for receiving and verifying entered data (col. 2 lines 6-18), and a means for updating entered and received data (col. 10 lines 46-53). As per the limitation of "preexisting data", Dworkin teaches a means for updating entered and received data (col. 10 lines 46-53), and furthermore teaches periodically updating data in a database, wherein an operator of the system can directly access and update the

database, wherein the operators access the database via an electronic connection such as telephone lines or modems (col. 4 lines 3-25, col. 10 lines 46-53).

As per the recitation of "a plurality of networked computers", Dworkin teaches a network of terminals connected to a central computer (Figure 1, col. 4 lines 3-12), wherein a database is connected to the computer (Dworkin; col. 1, lines 63-68 and fig. 1), and wherein the terminal is used for manually entering in data (col. 4, lines 3-12; col. 2, lines 6-18; and figure 1 of Dworkin). Furthermore, Bosco teaches an integrated group insurance system composed of workstations, wherein the workstations are personal computers which are networked to mainframe and minicomputers (col. 22 line 13 to col. 23 line 3).

One having ordinary skill in the art at the time of the invention would have found it obvious to apply the insurance sales and administration techniques, including accessing data via workstations, disclosed by Bosco within Dworkin's product searching, matching, and presentation system with the motivation of providing users the power or control to access the information regarding the insurance products offered by various vendors in different formats or styles, so that the user may obtain the products most suited to his or her needs and providing an information retrieval and input device from which all insurance functions may be performed (Bosco; col. 22 line 57 to col. 23 line 3).

The remainder of claim 10 is rejected for the same reasons given in the prior Office Action (paper number 11; section 11A, 11F, and 11I; pages 5-8, 11, and 12), and incorporated herein.

(C) As per the amendments to claim 11, it is respectfully submitted that these amendments were apparently made to overcome the rejection under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 101, set forth in the prior Office Action (paper number 11). However, these changes do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action (see paper number 11). As such, claim 11 is rejected under the same rationale given in the prior Office Action (paper number 11), and incorporated herein.

As per the recitation of "comparing user input against existing data entries stored in a computer network", note the teachings of Dworkin with regard to a terminal for manually entering in data (col. 4 lines 3-12, col. 2 lines 6-18, and Figure 1), a means for receiving and verifying entered data (col. 2 lines 6-18), and a means for updating entered and received data (col. 10 lines 46-53). In addition, Dworkin teaches a means for updating entered and received data (col. 10 lines 46-53), and furthermore teaches periodically updating data in a database, wherein an operator of the system can directly access and update the database, wherein the operators access the database via an electronic connection such as telephone lines or modems (col. 4 lines 3-25, col. 10 lines 46-53).

(D) As per the amendments to claims 16 and 17, it is respectfully submitted that these amendments were apparently made to overcome the rejection under 35 U.S.C. 112,

second paragraph, and under 35 U.S.C. 101, set forth in the prior Office Action (paper number 11). However, these changes do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action (see paper number 11). As such, these claims are rejected under the same rationale given in the prior Office Action (paper number 11), and incorporated herein.

(E) As per the amendments to claim 18, it is respectfully submitted that these amendments were apparently made to make claim 18 dependent on claim 17. These changes do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action (see paper number 11). As such, claim 18 is rejected under the same rationale given in the prior Office Action (paper number 11), and incorporated herein.

(F) Claim 19 has been amended to change claim 19 from “which may be selectively” modified to “configured to be” modified. These changes do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action (see paper number 11). As such, claim 19 is rejected under the same rationale given in the prior Office Action (paper number 11), and incorporated herein.

(G) As per the amendments to claim 20, it is respectfully submitted that these amendments were apparently made to overcome the rejection under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 101, set forth in the prior Office Action (paper number 11). However, these changes do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action (see paper number 11). As such, claim 20 is rejected under the same rationale given in the prior Office Action (paper number 11), and incorporated herein.

14. Claims 21-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (4,992,940) in view of Bosco et al. (5,191,522).

(A) As per claims 21-23, Dworkin discloses a system for automated selection of equipment for purchase through input of user desired specifications, comprising:

- (a) a network of terminals connected to a central computer (col. 4, lines 3-12 and figure 1 of Dworkin);
- (b) a database connected to the computer (Dworkin; col. 1, lines 63-68 and fig. 1);
- (c) a terminal for manually entering in data (col. 4, lines 3-12; col. 2, lines 6-18; and figure 1 of Dworkin);
- (d) means for receiving and verifying entered data (Dworkin; col. 2, lines 6-18);

- (e) means for updating entered and received data (Dworkin; col. 10, lines 46-53);
- (f) a database for storing data (Dworkin; col. 1, lines 63-68 and fig. 1);
- (g) means for displaying to the user a product set (reads on "data") (col. 10 line 65 to col. 11 line 16);
- (h) menu-driven means for defining a product in response to template (i.e., menu) selections made by a user (Dworkin; col. 5, lines 43-68 and figure 5); and
- (i) menu-driven means for obtaining vendor information, for obtaining product specifications, or for accepting and processing an order for a desired item a database connected to the computer for storing data (Dworkin; col. 7, line 7 to col. 8, line 37).

Dworkin is deficient in that his invention does not disclose a means for performing a plurality of insurance functions, such as cashiering, disbursements, document processing, and billing. However, this is only because Dworkin's exemplary embodiment is drawn to a different field, namely the field of computer hardware products (col. 5, lines 16-27). However, Dworkin does suggest the use of his methods to other products or services (col. 5, lines 28-34 and col. 10, lines 22-35).

Moreover, integrated computer network systems that specifically handle insurance matters are well known in the art, as evidenced by Bosco. In particular, Bosco's integrated group insurance information processing and reporting system operates on enterprise-wide network of stored program-controlled application workstation sub-systems and a relational database, wherein each application workstation (i.e., manual entry means) concerns one of the following general functions:

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insurance sales, insurance underwriting, insurance administration, or actuarial (abstract; figs. 1-9 & 12-13; col. 3, lines 25-45; and col. 22, line 40 to col. 23, line 3 of Bosco), and wherein the workstations are personal computers which are networked to mainframe and minicomputers (col. 22 line 13 to col. 23 line 3). Clearly, Bosco's system encompasses the insurance functions of cashiering, disbursements, document processing, and billing (Bosco; fig. 12). Moreover, Bosco teaches his integrated workstation to offer menu selections commensurate with the function to be performed by the operator (col. 22, lines 13-39). These menus are utilized in order to write and store necessary information, such as the insurance products and terms outlined in columns 4-19 of Bosco, into the relational database. Thus, Bosco teaches a menu-driven insurance product defining means. In addition, Bosco inherently receives an application for insurance products defined within his system, as supported by the fact that he discloses a means for flexible on-line access to contract, form, and general information that is captured by efficient forms filling, recording, and cloning processes (col. 26, lines 55-62).

One having ordinary skill in the art at the time of the invention would have found it obvious to apply the insurance sales and administration techniques disclosed by Bosco within Dworkin's product searching, matching, and presentation system with the motivation of providing users the power or control to access the information regarding the insurance products offered by various vendors in different formats or styles, so that the user may obtain the products most suited to his or her needs.

As per the recitation of a file server, Dworkin's teaching of many terminals connected to a central computer and database whereby the central computer can accommodate a large number of users (Dworkin; col. 4, lines 4-12) is functionally equivalent to the claimed file server.

Dworkin and Bosco fail to expressly disclose a first member of the plurality of functions being scheduled for immediate execution and a second member of the plurality of functions being scheduled for execution responsive to a queue. However, it would have been obvious to the skilled artisan to provide such a feature in the system disclosed collectively by Dworkin and Bosco with the motivation of serving users efficiently so that a user will not be required to wait unnecessarily for a long period of time to obtain information that is easily accessible to the system but is retarded in its transmission due to the retrieval or downloading of data that is more time-consuming to access. However, as per claims 21-22, it is noted that Bosco discloses a prospective pricing program module that performs the routine calculations necessary to determine premium needs for a prospective policy period for each case, wherein the rates can be determined and updated as necessary, and wherein the rates are provided for immediate and consistent use by departments (col. 27 lines 22-30 and col. 28 lines 3-8) (reads on "immediate execution" and "critical insurance function"). Furthermore, Bosco discloses a self administered billing program module for generating bills on a stated frequency which reflects the coverage, bill mode, bill categories, rate structure, and bill location (col. 24 lines 43-61) and reporting program modules for analyzing premiums, claims, and information system information (col. 26 line 4 to col. 27 line 10) (reads on

“queue” and “non-critical insurance function”). It is respectfully submitted that typically in insurance processing systems certain functions are performed immediately, such as premium calculations, to provide customers with immediate information, and certain functions, such as billing and reporting, are performed in batches based on a schedule such as once a month. It is well known in the art that billing and reporting require intensive data processing, and therefore the skilled artisan would have found it an obvious modification within the system taught collectively by Dworkin and Bosco to include billing and reporting as a “non-critical” insurance function with the motivation of reducing processing expenses and improving customer service (Bosco; col. 26 lines 10-20) by running billing, reporting, and other non-essential insurance functions during down time on the network (i.e., few users on the system). Furthermore, it is well known in the art that customers typically want premiums calculated immediately and it is clearly known in the art that a system would not run premium calculations as a batch process because customer's need the information immediately. Therefore, it would have been obvious to include calculating premiums immediately within the system taught collectively by Dworkin and Bosco with the motivation of improving customer service (Bosco; col. 26 lines 10-20) by providing customers with necessary information immediately.

As per claim 23, Bosco discloses a function of the enterprise-wide integrated computer system including rate calculation for premiums (col. 24 lines 43-50, col. 27 lines 22-30, and col. 29 line 48 to col. 30 line 31).

The remainder of claims 22 and 23 repeat the same limitations as claim 21, and are therefore rejected for the same reasons given for claim 21, and incorporated herein. The motivation for combining Bosco within Dworkin is given above in claim 21, and incorporated herein.

(C) As per claim 24, Dworkin's "templates" are analogous to questionnaires (Dworkin; col. 5, lines 43-68 and figure 5). Further, Dworkin's system reacts globally to the information entered by the user into these templates (Dworkin; col. 5, line 55 to col. 6, line 68).

(D) As per claim 25, Dworkin teaches a system programmed to accept inputs from the user from any or all of the set of product specifications via a number entered on a keyboard (col. 5 lines 55-68) and upon entering the specifications, searching a database for products fulfilling the indicated criteria (col. 6 lines 10-15). Furthermore, Dworkin discloses a terminal for manually entering in data (col. 4 lines 3-12, col. 2 lines 6-18, and Figure 1), a means for receiving and verifying entered data (col. 2 lines 6-18), and a means for updating entered and received data (col. 10 lines 46-53). In addition, Dworkin teaches a means for updating entered and received data (col. 10 lines 46-53), and furthermore teaches periodically updating data in a database, wherein an operator of the system can directly access and update the database, wherein the operators access the database via an electronic connection such as telephone lines or modems (col. 4 lines 3-25, col. 10 lines 46-53).

The remainder of claim 25 repeats the same limitations as claims 21-23 above, and is therefore rejected for the same reasons given for those claims, and incorporated herein. The motivation for incorporating Bosco's teachings within Dworkin's system is as discussed above in the rejection of claim 21.

(E) As per claim 26, Dworkin teaches programming a system to accept inputs from the user from any or all of the set of product specifications via a number entered on a keyboard (col. 5 lines 55-68) and upon entering the specifications, searching a database for products fulfilling the indicated criteria (col. 6 lines 10-15). The remainder of system claim 26 repeats the same limitations of system claims 21-23, and is therefore rejected for the same reasons given above for those claims, and incorporated herein. The motivation for incorporating Bosco's teachings within Dworkin's system is as discussed above in the rejection of claim 21.

(F) As per claim 27, Dworkin's "templates" are analogous to questionnaires (Dworkin; col. 5, lines 43-68 and figure 5). Further, Dworkin's system reacts globally to the information entered by the user into these templates (Dworkin; col. 5, line 55 to col. 6, line 68).

(G) Claim 28 differs from claims 21, 25, and 26 by reciting "distributed...." As per this element, Dworkin discloses a system including a computer connected to a database, wherein the database can be stored at some remote location, wherein the computer

communicates with many terminals, and wherein the terminals can be at the same location as the computer, or located remotely (reads on "distributed") (Fig. 1 and col. 3 line 60 to col. 4 line 12).

As per the recitation of an "auditing function", Bosco discloses having a detailed audit trail of transactions within his system (Bosco; col. 25, lines 30-32). The teaching of Bosco directed to the processing of agent-related information was discussed above in the rejection claim 21, and is incorporated herein. It would have been obvious to the skilled artisan to retrieve audit information stored in the method taught collectively by Dworkin and Bosco collectively by the person performing the function with the motivation of giving the person who initiated a transaction the opportunity to follow up and complete the same transaction, as he or she would be the most knowledgeable of the transaction and would have developed a rapport with the client in the time spent working on that transaction.

The remainder of claim 28 appears to be a compilation of the features of claims 21 and the features of claims 25 and 26, and is therefore rejected for the same reasons given for claims 21, 25, and 26, in combination. The teachings of Dworkin and Bosco relevant to the features of claim 28 are as discussed in the rejections of claims 21, 25, and 26 above, and incorporated herein.

(H) Claim 29 appears to be a compilation of the features of claims 21 and the features of claims 22-23, and is therefore rejected for the same reasons given for claims 21-23,

in combination. The teachings of Dworkin and Bosco relevant to the features of claim 29 are as discussed in the rejections of claims 21-23 above, and incorporated herein.

Response to Arguments

15. Applicant's arguments filed 24 April 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 24 April 2003.

(A) At pages 13-17 of the 24 April 2003 response, Applicant argues the teachings of the applied references individually with respect to claim 1. In addition, Applicant argues that certain features of the claimed invention are not taught by the applied reference. Furthermore, Applicant argues that the system taught in Dworkin is substantially different from the claimed invention and thus Dworkin is not applicable as a basis for a rejection under 35 U.S.C. 103(a). In particular, Applicant argues that "the plurality of networked computers", "Activity Processor", "Activity Scheduler", "means for predefining", and "menu driven means for defining a product in response to selections made by a user", recited in claim 1, are not taught in Dworkin, nor taught in the combination of Dworkin and Bosco.

In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the teachings that Applicant argues are missing from the Dworkin reference are clearly disclosed in the respective teachings of Bosco, when considered collectively with that of Dworkin, as discussed in detail within the prior Office Action (paper number 11) and in the preceding rejections, and incorporated herein.

Further, the features newly added and entered in the amendment filed 24 April 2003 have been shown to be fully disclosed by or obvious in view of the collective teachings of Dworkin and Bosco, as discussed above in detail within the preceding sections of the present Office Action.

Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In addition, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches an integrated system for the real time administration of an organization, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art would put the artisan in possession of this system. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not

determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al.*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In this case, Dworkin discloses a system and method for automated selection of equipment for purchase through input of user desired specifications and Bosco discloses an integrated group insurance information processing and reporting system operating on an enterprise-wide network of stored program-controlled application workstation sub-systems and a relational database, wherein each application workstation (i.e., manual entry means) concerns one of the following general functions: insurance sales, insurance underwriting, insurance administration, or actuarial. It is the position of the Examiner that the skilled artisan would be in possession of a computer system for the real time administration of an organization, such as that claimed in claim 1, when considering the teachings of Dworkin and Bosco, collectively, in combination with the knowledge of average skill in the art, for at least the reason that the skilled artisan would readily recognize that providing users the power or control to access information regarding insurance products offered by various vendors in different formats or styles, so that the user may obtain the products most suited to his or her needs.

As such, it is respectfully submitted that Applicant appears to view each of the applied references separately, in a vacuum, without considering the knowledge of average skill in the art, and that such piecemeal analysis is improper.

In response to the Applicant's arguments with respect to certain features of the claimed invention not being taught by the applied reference, the Examiner respectfully notes that the cited references were never applied as references under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per*

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se, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate

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obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In reference to Applicant's specific arguments with respect to the Dworkin and Bosco references, namely that the references fail to teach the features of "the plurality of networked computers", "Activity Processor", "Activity Scheduler", "means for predefining", and "menu driven means for defining a product in response to selections made by a user", recited in claim 1, the Examiner respectfully submits that Applicant's statements appear to be misdescriptive of the full teachings of Dworkin and Bosco collectively.

In particular, Applicant appears to cast Dworkin's system as "a network of terminals connected to a central computer" included in the centralized computer architecture of Dworkin and Bosco's system as "typically dumb terminals or personal computers which are networked to the mainframe and minicomputers of the integrated system." Firstly, it is unclear to the Examiner how the teachings of Dworkin and Bosco taken collectively do not teach a "plurality of networked computers" when clearly Dworkin discloses a network of terminals (see Figure 1) in combination with Bosco's teachings of personal computers networked to the mainframe and minicomputers for performing the functions of insurance sales, insurance underwriting, insurance administration, or actuarial (col. 22 lines 57-68). It is noted as discussed above that one cannot show non-obviousness by attacking references individually where, as here, the

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rejections are based on combinations of references. The skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the Examiner for the reasons and motivations given in the prior and present Office Action. Thus, the teachings of Dworkin and Bosco when considered with the knowledge that is generally available to one of ordinary skill in the art make obvious the limitations that Applicant disputes.

Secondly, Applicant apparently argues that Dworkin and Bosco fail to disclose a plurality of computers capable of independent processing, a local area network... providing distributed processing, or distributed processing of insurance data. In response, it is noted that these features upon which applicant relies (i.e., a plurality of computers capable of independent processing, a local area network... providing distributed processing, or distributed processing of insurance data) are not recited in claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it is noted that in Figure 13 of the Bosco reference, Bosco discloses distributed processing within his system.

Lastly, whether or not the Dworkin and Bosco references disclose other features such as the use of computing functions such as "spread sheets, word processing, calendar, diary, electronic mail, graphics, outside computer "dial up" service, etc." is immaterial to the issue at hand, since it is irrelevant whether the applied references contain steps or elements in addition to or beyond those claimed by Applicant, and not

required by Applicant, insofar as Applicant uses the word “comprising” at end of the preamble of each claim. The Examiner understands this claim language to mean “having at least”. If Applicant had intended to claim an invention that is exclusively limited to only those steps or elements specifically recited in the claims, it is respectfully submitted that the term “consisting of” should have been utilized rather than “comprising”.

In response to Applicant's argument that the references fail to show “at least one of said computers comprising an Activity Processor” and “at least one of said computers comprising an Activity Scheduler”, it is firstly noted that the features upon which Applicant relies (i.e., an activity processor configured to process activities responsive to an activity scheduler, the activity scheduler... schedules... activities to be processed by a workstation, an activity scheduler configured for predefining data in relation to processing time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Secondly, Dworkin clearly discloses, as discussed in the prior Office Action and present Office Action, a central computer or central processing unit, wherein the computer is programmed using known programming techniques (col. 3 lines 60-68 and col. 4 lines 1-12) for performing functions such as displaying menus and searching a database (Fig. 1 and 2A and col. 4 lines 35-61). Based on the Applicant's specification, an Activity Processor provides the functionality of “running programs” and an Activity Scheduler provides the functionality of monitoring and controlling processing (see page

13 lines 11-13), and therefore the Examiner respectfully submits that Dworkin's central programmed computer is functionally equivalent to the claimed "at least one computer comprising an Activity Processor" and "at least one computer comprising an Activity Scheduler." In addition, the disclosure of Dworkin, and not Bosco *per se*, was relied upon for the claimed structural elements, including the activity processor and activity scheduler.

Lastly, Applicant argues that Dworkin and Bosco fail to teach a "means for predefining" and that it is not clear how "serving users efficiently" bears on the issue of whether the claimed "means for pre-defining certain types of data for either immediate or subsequent processing" is obvious under 35 U.S.C. 103(a). In response to Applicant's concern that the references must explicitly teach or suggest every element of the combination as well as the motivation for combining the references, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. For example, the Court in *In re Fritch* stated "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. [emphasis added]" *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Each applied reference does not expressly suggest combination with the other respective

references; however, the Examiner has clearly shown that motivation for combining or modifying the applied references existed in the prior art. The "modification" referred to in *In re Fritch* involves extensive changes to the primary references. Such is not the case in the present combinations, where all modifications proposed by the Examiner are taught by the references and that knowledge generally available to one of ordinary skill in the art. Note, for example, the motivation explicitly stated at the first paragraph on page 8 of the previous Office Action (i.e., "serving users efficiently so that a user will not be required to wait unnecessarily for a long period of time to obtain information that is easily accessible to the system but is retarded in its transmission due to the retrieval or downloading of data that is more time-consuming to access.") furthermore, the Examiner has provided further support for the disclosure of "a means for predefining..." above in the rejection of claims 21-23 (see above section 14A). Note, the teachings of Bosco with regards to premium calculations, billing, and reporting. Therefore, the combination of references is proper and the rejection maintained. In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In response to Applicant's arguments that Dworkin and Bosco fail to teach a "menu driven means for defining a product in response to selections made by the user," the Examiner respectfully submits that the Applicant ignores the clear and unmistakable teachings of Dworkin with regard to a means for displaying to the user a product set (col. 10 line 65 to col. 11 line 16), a menu-driven means for defining a product in response to template (i.e., menu) selections made by a user (Dworkin; col. 5, lines 43-68 and figure 5), and a menu-driven means for obtaining vendor information, for obtaining product specifications, or for accepting and processing an order for a desired item a database connected to the computer for storing data (Dworkin; col. 7, line 7 to col. 8, line 37). Furthermore, the disclosure of Bosco, and not Dworkin *per se*, was relied upon for teaching elements within the claims directed toward an insurance company field, whereas Dworkin was relied upon primarily to teach the majority of the claimed structural elements. Note the teachings of Bosco as clearly discussed at page 7 of the previous Office Action with regards to "his integrated workstation to offer menu selections commensurate with the function to be performed by the operator (col. 22, lines 13-39). These menus are utilized in order to write and store necessary information, such as the insurance products and terms outlined in columns 4-19 of Bosco, into the relational database. Thus, Bosco teaches a menu-driven insurance product defining means." The skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the Examiner for the reasons and motivations given in the prior Office Action. Thus, the teachings of

Dworkin and Bosco when considered with the knowledge that is generally available to one of ordinary skill in the art make obvious the limitations that Applicant disputes.

Furthermore, in response to Applicant's argument that the references fail to show "defining a new insurance product" and "defining *new* products", it is noted that the features upon which applicant relies (i.e., "defining a new insurance product" and "defining *new* products") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Lastly, it is respectfully submitted that Applicant fails to appreciate the breadth of the claims, as presently recited with regards to a "menu driven means for defining a product in response to selections made my the user." For instance, there is no requirement that defining a product must be exclusively limited to a "new" product that are presently argued.

In response to Applicant's argument that Dworkin teaches away from using alternative systems or procedures for insurance products, such as the modification applied in the rejection (i.e., in combination with Bosco et al.), the Examiner maintains that it is clear as discussed in the previous Office Action that Dworkin's exemplary embodiment is drawn to a different field, namely the field of computer hardware products (col. 5, lines 16-27). However, Dworkin does suggest the use of his methods to other products or services (col. 5, lines 28-34 and col. 10, lines 22-35). Furthermore, the Examiner submits that the Dworkin reference does not teach away from the applied

combination of references or the Applicant's invention. Dworkin suggests several advantages that the invention is intended to provide for users, including facilitating the processing of services (col. 3 lines 9-11) and easily allowing users to obtain detailed specifications about any product offered for sale (col. 3 lines 3-5). Contrary to the Applicant's assertion, the proposed modification applied in the rejection of claim 1 does not render the disclosed invention unsatisfactory for the intended purposes(s) summarized by the cited passages of Dworkin. Moreover, when considering and applying prior art to claim limitations, alternate embodiments may be considered. According to MPEP §2123, "a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments." *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Dworkin discloses that his exemplary embodiment is drawn to a different field, namely the field of computer hardware products (col. 5, lines 16-27), however Dworkin does suggest the use of his methods to other products or services (col. 5, lines 28-34 and col. 10, lines 22-35). The Examiner interprets this phrasing to mean the aspects disclosed and summarized in the passage are parts of a limited or preferred embodiment that does not preclude other possible embodiments that have alternate configurations that still provide the disclosed advantages of the Dworkin system (col. 3 lines 3-11, col. 5, lines 28-34 and col. 10, lines 22-35).

(B) At pages 17-18 of the 24 April 2003 response, Applicant argues that Dworkin does not teach a "means for generating a series of questions to the user, and means for modifying the operation of said system to globally conform to the answers to said questions" as recited in claim 2.

In response, the Examiner respectfully submits that the Applicant ignores the clear and unmistakable disclosure of Dworkin with respect to "templates" that are analogous to questionnaires (Dworkin; col. 5, lines 43-68 and figure 5), wherein Dworkin's system reacts globally to the information entered by the user into these templates (Dworkin; col. 5, line 55 to col. 6, line 68). Furthermore, Dworkin clearly teaches asking the user for a choice using templates, wherein the system is programmed using known techniques, to accept inputs and choices from user for any or all of the specifications for a product through the templates, wherein upon entering the specifications for a product, the system searches a database for products fulfilling the indicated criteria within the template, and then displaying the results of the search, wherein the system displays the searches on one screen, however, if more entries in the database are found than will fit on one screen, the user can be prompted to view additional items on subsequent screen (reads on "means for modifying...") (Figure 5, col. 5 line 42 to col. 6 line 68). Thus, contrary to Applicant's allegation, the Examiner clearly set forth the specific portions of the Dworkin reference within the prior Office Action that teach "means for generating a series of questions to the user, and means for modifying the operation of said system to globally conform to the answers to said questions" as recited in claim 2. It is unclear to the Examiner as to why the Applicant

does not consider the system using templates for accepting input, and upon accepting the input, the system generating screens based on the search results to be a “means for generating a series of questions to the user, and means for modifying the operation of said system to globally conform to the answers to said questions.” Furthermore, the Examiner respectfully disagrees with the Applicant that the “templates” of Dworkin provide different functions than Applicant’s means for generating a series of questions. Clearly as discussed above, Dworkin’s system provides for the creation of templates to ask the user for a choice (col. 5 lines 43-68) and explicitly states at col. 5 lines 43-50 that the term “template” means a screen display which is analogous to a questionnaire. Therefore the Examiner maintains the position that Dworkin clearly discloses a “means for generating a series of questions to the user, and mean for modifying the operation of said system to globally conform to the answers to said questions”.

(D) At page 18 of the 24 April 2003, Applicant argues that it is not clear to the Applicant how the data/information listed within Bosco, constitutes “means for” accomplishing any task, much less the task of “defining four levels” as specified within claim 3. Further, Applicant argues that it is not clear to the Applicant how any of the application specific divisions of Bosco could fit the characterizations of claims 4-7.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, namely, “means for” defining four levels, it is noted that the features upon which applicant relies (i.e., “means for” with regards to defining four levels) are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted that claim 3 recites "means defining four levels, said levels comprising a database level, a company level, a product line level, and a product level, each said level comprising a series of parameters which may be selectively modified by the user, said system including means for modifying said parameters at the command of the user and means responsive to said modifying means for modifying said levels independently or collectively as required." As stated in the previous Office Action at pages 8-9 section C, "Bosco's enterprise-wide database is divided into four basic functions or levels: sales, underwriting, administration, and actuarial and includes data relating to producers, clients, cases, products, competitors, and claims (Bosco; figs. 12-13). Thus, the information contained in Bosco's enterprise-wide data base encompasses the limitations claimed in claims 3-7 (Bosco; columns 4-19). Moreover, one of Bosco's objectives within his invention is to modify and integrate insurance product and insurance administration information quickly and efficiently (col. 1, lines 42-54 and col. 2, lines 5-25 of Bosco)." Thus, contrary to Applicant's allegations that the limitations of claim 3 are not taught by Bosco, the Examiner has clearly set forth "a means defining four levels" as shown by Bosco's enterprise-wide database divided into different functions. Further, claim 3 clearly recites functional language in reciting "a series of parameters which may be selectively modified..." Thus, it is not clear whether this feature is actually performed by the claimed invention.

In response to Applicant's arguments that Bosco fails to teach the limitations of claim 5, namely "said company level comprises all data relating to a single corporate entity," the Examiner respectfully submits that Applicant ignores the teachings of Bosco with regard to a client subject or entity of the data structure or database, wherein the client subject comprises data relating to an external organization (company, association, or trust) (col. 4 line 30 to col. 5 line 32 and col. 10 lines 8-19). Furthermore, with regards to claims 4, 6, and 7, the Examiner clearly set forth the specific portions of the Bosco reference which disclosed those claims. In addition, the Examiner is concerned that, aside from merely alleging that certain claimed features of claims 4, 6, and 7, are not obvious from Dworkin and Bosco, essentially in the form of blanket statements, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out HOW the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

(E) At pages 18-19 of the 24 April 2003 response, Applicant's arguments with regard to claim 8 rely upon or re-hash issue addressed above, and are therefore moot in view of the responses given in sections 15(A) – 15(D) above, and incorporated herein.

(F) At page 19 of the 24 April 2003 response, Applicant argues that claim 9 recites "means for providing a retrievable audit history" and since this history encompasses processes executed on a "plurality of networked computers", and thus may include distributed events, the process is significantly different than generating an audit history of transactions on a "single relational database" as taught in Bosco.

Applicant's arguments with regard to claim 9 regarding "a plurality of networked computers" relies upon or re-hash issue addressed above, and are therefore moot in view of the responses given in sections 15(A) – 15(D) above, and incorporated herein.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, namely, "including distributed events", it is noted that the features upon which applicant relies (i.e., distributed events) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's arguments that Bosco fails to teach a "means for providing a retrievable audit history", the Examiner respectfully submits that Applicant ignores the teachings of Bosco with regard to having a detailed audit trail of transactions within his system (Bosco; col. 25, lines 30-32). Furthermore, a motivation was explicitly

stated on page 10 of the previous Office Action for the combination of Dworkin and Bosco of giving the person who initiated a transaction the opportunity to follow up and complete the same transaction, as he or she would be the most knowledgeable of the transaction and would have developed a rapport with the client in the time spent working on that transaction.

(G) At pages 19-20 of the 24 April 2003 response, Applicant argues that various features of claims 10-20 are not taught by the applied references.

In response, the Examiner is concerned that, aside from merely alleging that certain claimed features of claims 10-20, are not obvious from Dworkin and Bosco, essentially in the form of blanket statements, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out HOW the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

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Furthermore, Applicant argues that Dworkin does not teach “updating of said existing data... based on said user inputs” recited in claim 16. As per this recitation, note Dworkin’s teachings of a means for updating entered and received data (col. 10 lines 46-53), and furthermore teaches periodically updating data in a database, wherein an operator of the system can directly access and update the database, and wherein the operators access the database via an electronic connection such as telephone lines or modems to perform updates (col. 4 lines 3-25, col. 10 lines 46-53).

In addition, Applicant argues that each computer of the plurality of networked computers for performing certain functions as recited in claim 17 is not disclosed by Dworkin or Bosco. The Examiner has specifically given in the present Office Action and in the previous Office Action (paper number 11) with regards to the limitations of claim 17, evidence in the form of recitations of specific portions of the applied references, express articulation of the combinations and the motivations for combinations, as well as the scientific and logical reasoning of one skilled in the art at the time of the invention.

Lastly, Applicant argues that “a means for menu-driven creation of user-defined parameters for selected administrative functions” recited in claim 20 are not taught by the applied references. As per this recitation, note the teachings of Dworkin with regards to a means for displaying to the user a product set (col. 10 line 65 to col. 11 line 16), a menu-driven means for defining a product in response to template (i.e., menu) selections made by a user (Dworkin; col. 5, lines 43-68 and figure 5), and menu-driven means for obtaining vendor information, for obtaining product specifications, or for

accepting and processing an order for a desired item a database connected to the computer for storing data (Dworkin; col. 7, line 7 to col. 8, line 37). Furthermore, Dworkin teaches asking the user for a choice using templates, wherein the system is programmed using known techniques, to accept inputs and choices from user for any or all of the specifications for a product through the templates, wherein upon entering the specifications for a product, the system searches a database for products fulfilling the indicated criteria within the template, and then displaying the results of the search (Figure 5, col. 5 line 42 to col. 6 line 68). It is noted that screens are created (i.e., menus) depending on exactly what the user specifies to search for in the database. (col. 6 lines 1-25). Therefore, Dworkin taken in combination with Bosco's enterprise wide-integrated insurance system, including Bosco's menu-driven insurance product defining means as discussed in the rejections and arguments in the present and previous Office Action, collectively disclose "a means for menu-driven creation of user-defined parameters for selected administrative functions."

The remaining arguments with regard to claims 10-20 rely upon or re-hash issue addressed above, and are therefore moot in view of the responses given in sections 15(A) – 15(F) above, and incorporated herein.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a financial data processing system and method (4,774,664), a computer system and method for work

management (5,182,705 and 5,557,515), apparatus for insuring futures contracts against catastrophic loss (5,202,827), a database system for facilitating comparison of related information stored in a distributed resource (5,475,833), a prescription creation system (5,737,539), and a system for registering insurance transactions and communicating with a home office (5,903,873).

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-

3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

19. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

- | | |
|----------------|--|
| (703) 305-7687 | [Official communications; including After Final communications labeled "Box AF"] |
| (703) 746-8374 | [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"] |

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

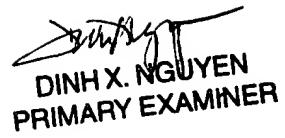
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CB

June 18, 2003


DINH X. NGUYEN
PRIMARY EXAMINER